

REMARKS/ARGUMENTS

Claims 1 and 4-10 are pending in the present application. Claims 8-10 have been cancelled. Claims 1, 8 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand (U.S. Pat. No. 1,196,252) in view of Wang (U.S. Pat. No. 6,305,249). Claims 8 and 10 have been cancelled. Claims 4 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wang as applied to claims 1 and 8 and further in view of Wyler et al. (U.S. Pat. No. 3,933,148). Claim 9 has been cancelled. Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wyler. Claims 6 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wyler as applied to claims 1 and 8 above and further in view of Wang. Claim 7 has been amended to depend on claim 1. Applicant respectfully traverses the rejections.

Independent claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wang. Independent claim 1 has been amended to first and second transverse walls wherein the first transverse wall separates the first and second compartments and the second transverse wall separates the second and third compartments. This amendment is consistent with the proposed amendment provided during a telephone conference with the Examiner in which the Examiner indicated this amendment likely overcomes the present rejection. Claim 7 has been amended to depend on claim 1 and thus claims 1-4 and 7 are considered in allowable form.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wyler. The

Applicant asserts that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness because the Wyler reference is not analogous art and should not be considered in an obviousness analysis. The reference relied upon by the Examiner must either be in field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

The Wyler reference relied upon by the Examiner is not in the Applicant's field of endeavor. When regarding the field of endeavor, the present invention deals particularly with a hammer driven punch holder. (Page 1, lines 8-13). In contrast, the Wyler reference is directed toward a device for determining skin sensitivity. (Col. 1, lines 33-37). The Wyler reference is not directed toward nor does it discuss a punch holding device. Consequently, this reference relied upon by the Examiner is not in the field of the inventor's endeavor and should not be relied upon.

The Wyler reference is not reasonably pertinent to the Applicant's problem. The Federal Circuit has clarified how to determine whether a reference is reasonably pertinent to the particular problem in which the endeavor was involved as follows:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commanded itself to the inventor's attention in considering his problem. ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 966 F.2d 656, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992). (Emphasis added); See also, MPEP § 2141.01(a).

According to the Applicant's specification, the purpose of the present invention is "to provide a punch holder and storage tool which can easily hold the driven punch by one hand at a safe distance from the hammer." (Page 1, lines 18-21). The purpose of the Wyler reference is to "provide a device for accurately measuring the sensitivity of skin utilizing a standardized pressure element." (Col. 1, lines 43-45).

The Applicant's reference has a different purpose as compared to that of the Wyler reference. Specifically, the Applicant's reference is for providing a punch holder and storage tool which can easily hold a punch at a safe distance from a hammer, whereas the Wyler reference is for providing a device that will accurately measure the sensitivity of skin using a standardized pressure element. Therefore, Wyler solves a different problem than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the reference cited by the Examiner. Because the reference relied upon by the Examiner is not in the field of the inventor's endeavor and is not reasonably pertinent to the specific problem with which the inventor is involved, the Wyler reference is not analogous and should not be considered in an obviousness analysis. Thus, because Wyler is not analogous art the Applicant asserts that the Examiner has not shown a *prima facie* case of obviousness and respectfully requests the obviousness rejection to claim 5 be withdrawn. Additionally, claim 6

depends on claim 5 and for at least this reason is also considered in allowable form.

In view of the above amendments and remarks, Applicant believes claims 1 and 4-7 are in condition for allowance, and applicant respectfully requests allowance of such claims.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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